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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,591	05/03/1999	TAKANORI NAMBU	JA171	9975

27752 7590 10/15/2002

THE PROCTER & GAMBLE COMPANY
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EXAMINER

CHOI, FRANK I

ART UNIT PAPER NUMBER

1616

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/297,591

Applicant(s)

NAMBU, TAKANORI

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

The request filed on 12/18/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/297,591 is acceptable and a CPA has been established. An action on the CPA follows.

Specification

The disclosure is objected to because of the following informalities:

Pg. 12, line 9, "CARTARETINE" should be "CARTARETIN".

Page 15, line 8, "TETEN" is appears to be misspelled. Examiner has been unable to locate any polymer listed under the tradename "TETEN".

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In Claim 4, there are variables "R¹" and "R²" which do not appear to be set forth in the specification. Examiner notes that the definition of variable "R¹" appears to correspond to "R⁵" in the specification and that the description of variable "R²" appears to correspond to "R⁶" in the specification (See Specification, pg. 4, lines 32,33).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to describe an amphoteric polymer which contains unit (b) which also does not contain unit (a) or an amphoteric polymer which contains unit (c) which also does not contain units (a) and (b) (See Specification, pgs. 3,4). As such, it does not appear that based on the Specification as originally filed that a skilled artisan would immediately envisage an amphoteric polymer as described in claim 4.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: If unit (b) is present than unit (a) must be present and if unit (c) is present than units (a) and (b) must be present (See Specification, pgs. 3, 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Grollier et al. for the reasons of record set forth in the prior Office Actions and the further reasons below.

Grollier et al (U.S. 4,240,450) was discussed in the prior Office Actions and the same is incorporated herein.

Examiner had duly considered Applicant's arguments but deems them unpersuasive.

The test for obviousness is not that the claimed invention must be expressly suggested in the references. Rather, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981).

Applicant argues that there is no motivation to use the claimed amounts. Herein, the reference teaches the use of a combination of amphoteric, cationic and anionic polymers and non-ionic surfactants. As such, it would have been well within the skill of one of ordinary skill of art to arrive at the various amounts through optimization of the prior art values depending on the desired characteristics of the composition, for example, length of hold, flexibility, resistance to humidity and foaming. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955) (“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”); See also *In re Hoeschele*, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). As such, one of ordinary skill would be motivated to modify the prior art as above with the expectation of modifying said characteristics as desired.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajino et al. (U.S. Pat. 5,254,333) for the reasons of record set forth in the prior Office Action (1/11/01) and the further reasons below.

Kajino et al. was discussed in the prior Office Action (1/11/01) and the same are incorporated herein.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

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The test for obviousness is not that the claimed invention must be expressly suggested in the references. Rather, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981).

Applicant argues that there is no motivation to use the claimed amounts. Herein, the reference teaches the use of a combination of amphoteric, cationic and anionic polymers and non-ionic surfactants. As such, it would have been well within the skill of one of ordinary skill of art to arrive at the various amounts through optimization of the prior art values depending on the desired characteristics of the composition, for example, length of hold, flexibility, resistance to humidity and foaming. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955) (“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”); See also *In re Hoeschele*, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). As such, one of ordinary skill would be motivated to modify the prior art as above with the expectation of modifying said characteristics as desired. Furthermore, one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation of formulating a hair treatment composition that imparts of good feeling to hair and is safe to hair and skin (Column 2, lines 1-11).

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Conclusion

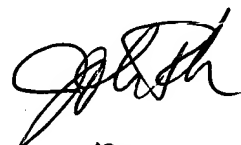
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

October 10, 2002


JOHN PAK
PRIMARY EXAMINER
GROUP 1600

